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July 19 2006  
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**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**Trademark Trial and Appeal Board**

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In re Pair of Oaks, Inc.

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Serial No. 78398313

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Matthew T. Welker of White-Welker & Welker, LLC for Pair of Oaks, Inc.

Fred Mandir, Trademark Examining Attorney, Law Office 105 (Thomas G. Howell, Managing Attorney).

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Before Hohein, Walters and Kuhlke, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Pair of Oaks, Inc. has filed an application to register on the Principal Register the mark "BIG CHIEF MOTORSPORTS," in standard character form in the manner shown below,

Big Chief  
MotorSports

for "motorized scooters and ATVs" in International Class 12.<sup>1</sup>

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<sup>1</sup> Ser. No. 78398313, filed on April 7, 2004, which is based on an allegation of a date of first use anywhere of December 1, 2003 and a date of first use in commerce of March 1, 2004. The term "MOTORSPORTS" is disclaimed.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its goods, so resembles the mark "BIG CHIEF," which is registered on the Principal Register in standard character form for "engine parts, namely, cylinder heads for high performance motor vehicles" in International Class 7,<sup>2</sup> as to be likely to cause confusion, or to cause mistake, or to deceive.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity or dissimilarity in the goods or services at issue and the similarity or dissimilarity of the respective marks in their entireties.<sup>3</sup>

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<sup>2</sup> Reg. No. 2,793,526, issued on December 16, 2003, which sets forth a date of first use anywhere and in commerce of May 9, 1990.

<sup>3</sup> The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks." 192 USPQ at 29.

Turning first to consideration of the respective goods, applicant contends in its brief that because its goods "are motorized scooters and ATVs, while the cited registration, in a different International Class, is limited to a cylinder head for a motor vehicle," the differences in such goods "cause the products for both Applicant and the registered mark to travel and be advertised in different trade channels." Applicant also asserts that "because of the expense of the products ..., consumers invest significant amounts of time in research before purchasing either [applicant's or registrant's] good[s]."

Applicant, in particular, stresses that "the cited registration covers 'engine parts, namely cylinder heads for high performance motor vehicles' in International Class 007" and thus "is limited to cylinder heads for motor vehicles, specifically not scooters or ATVs, while Applicant's goods and related engine parts are specifically limited to and related to scooters and ATVs" (underlining in original). While acknowledging that it "has been consistently found by this Board that manufacturers of vehicles also produce accessories and attachments for these goods and market them under the same mark, which may lead to confusion by the average person," citing *In re General Motors Corp.*, 23 USPQ2d 1465, 1468-69 (TTAB 1992), applicant argues that:

In the present case, Applicant sells motorized scooters and ATVs, which are not related and do not share components with motor vehicles. More specifically, if Applicant was to sell a high performance cylinder head for a motorized scooter or ATV, it would not fit or be marketed in the same channels as a high performance cylinder head for a motorized vehicle, such as a car or truck.

Although applicant fails to explain why it apparently considers its motorized scooters and ATVs not to be motor vehicles when it is plain that such goods are indeed motor vehicles, applicant contends that the "clear differences" between its goods and those of registrant, as well as the differences in their respective channels of distribution, "reduce the likelihood of confusion between the marks."

Applicant, in this regard, emphasizes that (underlining in original):

The target audiences and channels of trade for the respective goods ... are different. Applicant's motorized scooters and ATVs are sold directly or through a distributor and are targeted at those with an interest in fuel economy transportation, short distance travel or off-road exploration, farm-work, or assistance in moving things over terrain inaccessible by a motor vehicle. Applicant's motorized scooters and ATVs are not advertised or promoted in trade journals or magazines for high performance motor vehicles or parts and accessory catalogs for high performance motor vehicles.

Conversely, the products of the cited registration are offered for sale directly through distributors of parts for high performance motor vehicles such as drag racecars, asphalt and dirt track oval racecars, and off-road racecars. .... Registrant may or may not provide modified cylinder heads for a motorized scooter or ATV. Regardless, any presumption that Registrant's ... [goods] include selling complete motorized scooters or ATVs would be in error, as these products are not normally associated with high performance motorized vehicle cylinder heads.

....

The goods ... of the Applicant and Registrant are marketed under completely

different circumstances and to different consumers, thereby minimizing the likelihood of confusion, and it is highly unlikely that a purchaser would assume that these goods ... have a common origin. The goods associated with BIG CHIEF MOTORSPORTS are not designed to be used in high performance motor vehicles and are not comparable to or interchangeable with those of the Registrant. Applicant's goods are not high performance equipment, but smaller, lower occupancy motorized transportation device such as scooters and ATVs.

Furthermore, applicant argues that the related *du Pont* factor of the sophistication of customers for the respective goods serves to preclude any likelihood of confusion in that:

Even assuming, *arguendo*, that the channels of trade for the goods ... overlap in some instances, it is reasonable to assume that ordinary consumers of Registrant's cylinder heads, a specialized manipulation of an OEM design or all-out specialized product, will investigate before making a purchase based on factors such as the intended purpose, function, reputation, and importantly the source, of the ... [goods]. The purchase of specialized cylinder heads and high performance engine building in particular, which often includes the purchase of expensive equipment that typically must be machine[d]-to-fit exactly, represents a significant investment of time and expense to study the available providers for one's field of interest or type of performance engine, and evaluate the product's expertise and usefulness before making an informed purchasing decision.

While a purchaser of a motorized scooter or ATV, like the purchaser of an automobile, receives a complete item and not a specialized component, a purchaser of a high-performance cylinder head typically spends a significant amount of time comparing models and invests significant time, expense, and energy into evaluating different models (specifications), manufacturers (history of quality, location), and distributors (price and after-purchase service and maintenance) before making an informed purchase.

Both sets of consumers will carefully deliberate and reflect before making purchases based on factors such as the intended purpose, function, and the reputation of the manufacturer of the goods. Therefore, while it is possible that someone may note the similarities among the marks themselves, purchasers of either Applicant's motorized scooters and ATVs or Registrant's high performance motorized vehicle cylinder heads would be able to discern that these goods ... are unrelated. It is not likely that relevant consumers would be confused by the marks.

The Examining Attorney, on the other hand, has presented sufficient evidence to establish that, as respectively set forth in the application and cited registration, the goods at issue are commercially related. As he correctly notes in his brief, the respective goods need not be identical or directly competitive in order for there to be a likelihood of confusion. Instead, it is sufficient that the respective goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 156, 223 USPQ 1289, 1290 (Fed. Cir. 1984); *Monsanto Co. v. Enviro-Chem Corp.*, 199 USPQ 590, 595-96 (TTAB 1978); and *In re International Telephone & Telegraph Corp.*, 197 USPQ 910, 911 (TTAB 1978). Moreover, it is well settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are set forth in the

application and the cited registration, and not in light of what such goods may actually be. See, e.g., Octocom Systems Inc. v. Houston Computer Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990); Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank, 811 F.2d 1490, 1 USPQ2d 1813, 1815-16 (Fed. Cir. 1987); CBS Inc. v. Morrow, 708 F.2d 1579, 218 USPQ 198, 199 (Fed. Cir. 1983); Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 940 (Fed. Cir. 1983); and Paula Payne Products Co. v. Johnson Publishing Co., Inc., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973).<sup>4</sup>

Here, as the Examining Attorney observes in his brief, the cited registrant's goods are identified as "engine parts, namely, cylinder heads for high performance motor vehicles." Pointing out, in addition, that The American Heritage Dictionary of the English Language (3rd ed. 1992) defines "vehicle" in relevant part as "[a] self-propelled conveyance that runs on tires; a motor vehicle" and lists "all-terrain vehicle" as "[a]bbr. ATV A small, open motor vehicle having one seat and three or more wheels fitted with large tires. It is designed

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<sup>4</sup> To the extent, furthermore, that applicant is arguing that confusion is unlikely because the goods at issue are in different classes, suffice it to say that the purpose of the United States Patent and Trademark Office in using the classification system is for administrative convenience rather than as an indication of whether goods are related or not. See, e.g., Jean Patou Inc. v. Theon Inc., 9 F.3d 1171, 29 USPQ2d 1771, 1774 (Fed. Cir. 1993); National Football League v. Jasper Alliance Corp., 16 USPQ2d 1212, 1216 n.5 (TTAB 1990); and In re Leon Shaffer Golnick Advertising, Inc., 185 USPQ 242, 242 n.2 (TTAB 1974). The fact, therefore, that applicant's goods and those of the cited registrant are classified in different classes is not an indication that the respective goods are unrelated; instead, such fact is simply immaterial in determining the issue of likelihood of confusion. See, e.g., In re Clay, 154 USPQ 620, 621 (TTAB 1967) and cases cited therein.

chiefly for recreational use over roadless, rugged terrain,"<sup>5</sup> he properly notes that (emphasis in original):

The term "motor vehicles" is a broad term that includes "motorized scooters and ATVs." ***Since "motorized scooters and ATVs" are motor vehicles, the scope of registrant's goods encompasses "engine parts, namely, cylinder heads for high performance motorized scooters and ATVs."***

....

***Applicant's goods are identified as "motorized scooters and ATVs." The scope of applicant's goods encompasses high performance motorized scooters and ATVs.*** See attached to the 4/21/05 Office action, the Google search evidence referencing the high performance ATV market and showing companies marketing high performance scooters and ATVs.

....

Therefore a proper analysis under Trademark Act Section 2(d) for the present case would include comparing ***"engine parts, namely, cylinder heads for high performance motorized scooters and ATVs"*** to ***"high performance motorized scooters and ATVs."***

As support for his position, the Examining Attorney maintains that the record contains "copies of several third-party registrations which show that others have applied the *same mark* to goods that are closely related to, or identical to, *applicant's goods and the registrant's goods*" (emphasis in original). The two most pertinent of such registrations, which are each based upon use in commerce, show that in one instance, a

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<sup>5</sup> Inasmuch as the Board may properly take judicial notice of dictionary definitions, the Examining Attorney's request in his brief that judicial notice be taken of such definitions is granted. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983); and *Marcal Paper Mills, Inc. v. American Can Co.*, 212 USPQ 852, 860 n.7 (TTAB 1981).



mark is registered for "engine cylinder heads" in International Class 7, on the one hand, and "all terrain vehicles ... [and] scooters" in International Class 12, on the other hand, while in the other instance, a mark is similarly registered for "[p]arts for motors and engines for use in ... ATVs, namely, ... engine heads" in International Class 7 as well as "ATVs" in International Class 12. It is settled that while use-based third-party registrations are not proof that the different marks shown therein are in use or that the public is familiar with them, it nevertheless is the case that such registrations have some probative value in that they serve to suggest that the various goods listed therein are of the kinds which may emanate from a single source. See, e.g., In re Infinity Broadcasting Corp. of Dallas, 60 USPQ2d 1214, 1217-18 (TTAB 2001); In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993); and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 at n.6 (TTAB 1988), *aff'd as not citable precedent*, No. 88-1444 (Fed. Cir. Nov. 14, 1988).

More importantly, the Examining Attorney, as indicated previously, has also made of record in support of his position excerpts from various websites on the Internet showing that there are in fact categories of motorized scooters and ATVs which are known as "high performance" products. Specifically, an excerpt on "Gas Scooter" from the "TrendTimes.com" website refers to the "Bladez scooter Moby XL COMP 40cc" model as "simply the ultimate anyone can aspire to own in the category of a **high performance**

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**gas scooter**," while an excerpt advertising "Motorized Scooters" at the website "[www.speedysat.com/fast\\_gas\\_scooters.html](http://www.speedysat.com/fast_gas_scooters.html)" states that "[i]f you're looking for a **high performance scooter** with speed and endurance, then a fast gas scooter is your ideal choice. Fast gas scooters are similar to electric scooters in appearance, but are powered by a gas tank that fuels either a two-stroke or four-stroke engine rather than electricity" (emphasis added).

Likewise, a review of the YAMAHA 2001 660R Raptor" ATV in the website of "ATV Connection Magazine" contains the following references to "high-performance ATV(s)" (emphasis added):

The consistent leader in the sport and **high-performance ATV** market, Yamaha has announced the latest edition to its sport ATV lineup, the 660 Raptor. The emergence of the new 660 Raptor brings Yamaha's total Sport/**High-Performance ATV** family to five models strong. ....

Everything about the 660 Raptor demonstrates why it is a predator without equal. Yamaha began developing this beast to create the ultimate **high-performance ATV**. ....

With a narrow chassis and 660CC 5-valve SOHC engine, the 660R Raptor ups the ante rewarding the rider with a feature not found on other **high-performance ATVs**: reverse. ....

To enhance the riding pleasure, the 660R Raptor features electric start, a feature uncommon on **high-performance ATVs**. ....

....

Power and handling may be the most important elements on a **high-performance ATV**, but Yamaha engineers did not overlook the

importance of keeping weight to a minimum.  
....

To the same effect, the "HONDA MEDIA NEWSROOM" website, in recounting the "Honda ATV Model History Timeline, 1970-Present," states among other things that (emphasis added):

1986 FourTrax 250R (TRX250R)  
Honda's introduces the definitive **high-performance ATV** in the FourTrax 250R. Equipped with a liquid-cooled counterbalanced two-stroke single-cylinder engine, ... the 328-pound 250R is designed for expert riders seeking the ultimate sport/competition ATV.

....

1999 FourTrax 400EX (TRX400EX)  
Honda's first **high-performance ATV** in more than a decade immediately awakens the sleeping ATV sport industry. ....

Similarly, an excerpt of the product review entitled "KAWASAKI INTRODUCES KFX400 SPORT MODEL ATV," which appeared on the "ATV SOURCE" website, indicates that such "400cc **high performance ATV** fills important slot for Kawasaki brand of fun" (emphasis added) in that:

Kawasaki Motors Corp., U.S.A. has re-entered the ultra-**high-performance all-terrain vehicle (ATV)** market with an all-new sport model for 2003.

For sport ATV enthusiasts who fondly remember the Kawasaki Tecare® of 1988, the all-new KFX400 will generate excitement with its competition styling, lithe chassis and **high-performance engine**. ....

....

The KFX400 is Kawasaki's new ultra-**high-performance** sport-model **ATV**. ....

Circumstances are thus such that purchasers and prospective customers for high performance scooters and high

performance ATVs would consider engine parts for those goods, including, cylinder heads, to be commercially related products which, in view of the specialized nature of the respective goods, would likely be available in the same channels of trade, namely, dealerships in scooters and/or ATVs. Moreover, while the respective goods, as applicant contends, would on account of their nature be sold primarily, if not exclusively, to careful and discriminating purchasers, it is still the case, as the Examining Attorney also points out in his brief, that it is well established that the fact that purchasers are knowledgeable and sophisticated in their choice of goods "does not necessarily preclude their mistaking one trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Research & Trading Corp.*, 793 F.2d 1276, 230 USPQ 49, 50 (Fed. Cir. 1986); *In re Decombe*, 9 USPQ 1812, 1814-15 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558, 560 (TTAB 1983); and TMEP §1207.01(d)(vii). If such products consequently were to be sold under the same or similar marks, confusion as to the source or sponsorship thereof would be likely to occur.

Turning, therefore, to consideration of the marks at issue, applicant asserts in its brief that its "BIG CHIEF MOTORSPORTS" mark and the cited registrant's "BIG CHIEF" mark "are completely different terms that convey completely different meanings" due to the inclusion in its mark of the term "MOTORSPORTS." Specifically, applicant maintains that "the mark

'BIG CHIEF' refers to a sole product, that being a cylinder head for a motor vehicle, while [the mark] 'BIG CHIEF MOTORSPORTS' refers to multiple, different products, being scooters and ATVs." While additionally noting that, during the prosecution of its application, the Examining Attorney cited and later withdrew a registration by a third-party involving the mark "CHIEF" for "motorcycles,"<sup>6</sup> applicant contends that because marks must be considered in their entireties, "there is no rule that confusion is automatically likely if a junior user has a mark that contains in part the whole of another's mark," citing in support of such proposition the following cases:

*Colgate-Palmolive Co. v. Carter Wallace, Inc.*, 432 F.2d 1400, 167 U.S.P.Q. 529 (C.C.P.A. 1970) (PEAK PERIOD not confusingly similar to PEAK); *Lever Bros. Co. v. Barcolene Co.*, 463 F.2d 1107, 174 U.S.P.Q. 392 (C.C.P.A. 1972) (ALL CLEAR not confusingly similar to ALL); [and] *In re Ferrero*, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973) (TIC TAC not confusingly similar to TIC TAC TOE).

The Examining Attorney, however, argues in his brief that overall the marks at issue are so substantially similar that their contemporaneous use in connection with the respective goods would be likely to cause confusion as to the origin or affiliation thereof. Citing the dictionary definition, which he made of record from the "infoplease" website, of "motorsports" as meaning "competitions, esp. races, involving motor vehicles, as automobiles, motorboats, or motorcycles," the Examining Attorney properly observes in his brief that:

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<sup>6</sup> Reg. No. 2,388,763, issued on September 19, 2000, which sets forth a date of first use anywhere and in commerce of June 1, 1999.

In comparing the respective marks, "Big Chief MotorSports" and "BIG CHIEF," it is apparent that the dominant terms in both marks are the virtually identical wording "Big Chief" and "BIG CHIEF." Applicant's mark also contains the merely descriptive wording "MotorSports" which has been disclaimed by applicant. Disclaimed matter is typically less significant ... when comparing marks. Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entirety, one feature of a mark may be more significant in creating a commercial impression. See *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001 (Fed. Cir. 2002).

Applicant argues ... that the respective marks are completely different terms that convey completely different meanings. However, consumers would reasonably believe that the respective marks, "Big Chief MotorSports" and "BIG CHIEF" as applied to related products[,] are two marks owned by the same entity. The same would be true, e.g., if the marks HONDA and HONDA MotorSports were applied to related goods. The mere addition of a [merely descriptive] term to a registered mark does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Section 2(d). In *re Chatam International Inc.*, 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004).

We agree with the Examining Attorney that, when viewed in their entirety, the presence of the merely descriptive term "MOTORSPORTS" in applicant's "BIG CHIEF MOTORSPORTS" mark is insufficient to overcome the substantial identity of such mark to the cited registrant's "BIG CHIEF" mark in sound, appearance, connotation and commercial impression due to the shared term "BIG CHIEF." As the Examining Attorney correctly notes, while the marks at issue must be considered in their entirety, including

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any descriptive matter therein, our principal reviewing court has indicated that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, "there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided [that] the ultimate conclusion rests on consideration of the marks in their entireties." In re National Data Corp., 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For instance, according to the court, "that a particular feature is descriptive ... with respect to the involved goods ... is one commonly accepted rationale for giving less weight to a portion of a mark ...." Id. See also, Hewlett-Packard Co. v. Packard Press Inc., supra at 62 USPQ2d 1004. In addition, contrary to applicant's assertion, in this case the presence of the merely descriptive term "MOTORSPORTS" in applicant's mark serves to heighten the similarity between the respective marks in overall commercial impression since it is indicative of high performance models of motorized scooters and ATVs for use in motorsports events, the same field in which registrant's "BIG CHIEF" engine cylinder heads for high performance motor vehicles would be utilized. See, e.g., Hewlett-Packard Co. v. Packard Press Inc., supra at 62 USPQ2d 1004.<sup>7</sup>

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<sup>7</sup> As our principal reviewing court stated therein:

Given the descriptive nature of the disclaimed word "Technologies," the Board correctly found that the word "Packard" is the dominant and distinguishing element of PACKARD TECHNOLOGIES. .... Thus, as the Board correctly noted, the dominant portion of Packard Press's mark is identical to a prominent portion of [the registrant] HP's HEWLETT PACKARD marks.

We accordingly conclude that customers and prospective consumers who are familiar or acquainted with the cited registrant's "BIG CHIEF" mark for "engine parts, namely, cylinder heads for high performance motor vehicles," would be likely to believe, upon encountering applicant's substantially similar "BIG CHIEF MOTORSPORTS" mark for "motorized scooters and ATVs," that such commercially related products emanate from, or are sponsored by or associated with, the same source. To the extent, however, that applicant's contentions, as well as the presence of a third-party registration for the mark "CHIEF" for "motorcycles," may serve to raise any doubt as to our conclusion in this regard, we resolve such doubt, as we must, in favor of the cited registrant. See, e.g., In re Chatam International Inc., supra at 71 USPQ2d 1948; In re Martin's Famous Pastry Shoppe, Inc., supra at 223 USPQ 1290; and In re Pneumatiques Caoutchouc Manufacture et Plastiques Kelber-Columbes, 487 F.2d 918, 179 USPQ 729, 729 (CCPA 1973).

**Decision:** The refusal under Section 2(d) is affirmed.

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Moreover, in the present case, the inclusion of "Technologies" serves to increase, rather than decrease, the similarity in overall commercial impression. HP's HEWLETT PACKARD registrations specify numerous computer and computer-related goods and services. Indeed, HP is heavily involved in the technology field. Thus, consumers familiar with the HEWLETT PACKARD marks and HP's technology-based goods and services would likely associate the PACKARD TECHNOLOGIES mark in some way with HP. Thus, even though Packard Press's PACKARD TECHNOLOGIES mark does not incorporate every feature of the HEWLETT PACKARD marks, the marks create a similar overall commercial impression.

Id.